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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,060	02/12/2002	David Mu	38002-0024	2406
26633	7590	05/15/2007		
HELLER EHRMAN LLP 1717 RHODE ISLAND AVE, NW WASHINGTON, DC 20036-3001			EXAMINER GIBBS, TERRA C	
			ART UNIT 1635	PAPER NUMBER
			MAIL DATE 05/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/073,060	Applicant(s) MU ET AL.	
	Examiner Terra C. Gibbs	Art Unit 1635	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1, 3, 9, 11, 22, 24, 39, 40, 42, 44, 45, 47, 49-53, 58-70, 73, 74 and 77-82.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

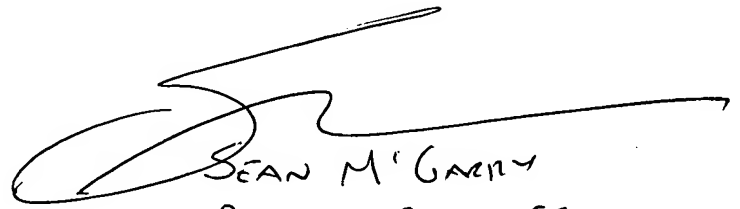
8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 5. Applicant's reply has overcome the following rejection(s): Applicant's reply has overcome the 35 U.S.C. 112, second paragraph rejection of record.

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1,3,9,11,22,24,39,40,42,44,45,47,49-53,58-70,73,74 and 77-82 would remain rejected under 35 U.S.C. 112, first paragraph as lacking enablement as it would require undue experimentation for one of skill in the art to perform the methods commensurate in scope with the claims. The issue is that all of the claims encompass in vivo applicability, where the specification does not specify any examples of such well-established in-vivo model systems or evidence for the predictable association of hepsin expression or amplification to correlate with the cancers, methods of diagnosis, or treatment regimens recited in the claims. In the previous Final Office Action mailed January 12, 2007, all pending claims of record were rejected for this very reason. In response to this rejection, Applicants contend that the claims have been amended to recite subject matter which the Final Office Action acknowledges is enabled. It is noted that in Applicant's Amendment filed April 10, 2007, claims 1, 9, 22, 52, 59, and 62 were amended where the term "biological subject" was replaced with the term "biological sample". These amendments do not obviate the instant rejection of record since the instant specification at page 22, 4th paragraph discloses, "'Biological sample' as used herein is a biological subject in vivo or in situ". Therefore, given this disclosure, the pending claims of record do not exclude in vivo applicability for enablement purposes. Thus, given the broad claims in an art whose nature is identified as unpredictable, the large quantity of research required to define these unpredictable variables, the lack of guidance provided in the specification, the absence of a working example in vivo and the teachings in the prior art balanced against the high skill level in the art, it is the position of the Examiner that it would require undue experimentation for one of skill in the art to practice the methods commensurate in scope with these claims.



SEAN M'GARRY
PRIMARY EXAMINER
AU 1635